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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,850	01/13/2004	Steven C. Quay	018072-000610US	3414

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EXAMINER

ANDERSON, REBECCA L

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

04/04/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/756,850

Applicant(s)

QUAY, STEVEN C.

Examiner

REBECCA L. ANDERSON

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 109, 112-114, 120-122 and 124 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 109, 112-114 and 120-122 is/are rejected.
7) ☒ Claim(s) 124 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 13 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claims 109, 112-114, 120-122 and 124 are currently pending in the instant application. Claims 1-9, 112-114 and 120-122 are rejected. Claim 124 is objected.

Response to Amendment and Arguments

Applicants' amendment and arguments filed 7 January 2008 have been considered and entered into the application. Applicants amendment has overcome the objection of claims 121 and 122 as being duplicates of claims 115 and 116 as claims 115 and 116 have been cancelled. Applicants' amendment has overcome the objection to claims 109, 112-114, 119 and 120 as containing non-elected subject matter as applicant has amended the claims to the elected invention. Applicants' amendment has overcome the 35 USC 112 2nd paragraph rejection of claims 109, 112-116 and 119-122 as the phrase the definition of -OR3 and -OR6 as "a leaving group" has been deleted from the claims. However, the amendment has necessitated a new 35 USC 112 2nd paragraph rejection and a 35 USC 112 1st paragraph rejection of claims 109, 112-114 and 120-122 as it is unclear what the variables -OR3 and -OR6 are when they are defined as "reactive under relatively mild conditions". In addition, the phrase "reactive under relatively mild conditions" in association with -OR3 or -OR6 is considered new matter. While applicant argues that support for the amendment to the definitions of -OR3 and -OR6 is found at paragraph [0082], it is noted that the phrase "under relatively mild conditions" is associated with favored classes of reactions available and is not associated with definitions for -OR3 and -OR6. These favored classes of reactions are discussed as nucleophilic substitutions, electrophilic substitutions and additions to

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carbon-carbon and carbon-heteroatom multiple bonds. Therefore, the definition of –OR3 and –OR6 as “reactive under relatively mild conditions” is considered new matter as this definition is found nowhere in the originally filed disclosure.

Claim Objections

Claim 124 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 109, 112-114 and 120-122 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the definition of –OR3 and –OR6 as “reactive under relatively mild conditions” is considered new matter. The phrase “under relatively mild conditions” is associated with favored classes of reactions available and is not associated with definitions for -OR3 and -OR6, see page 16. These favored classes of reactions are discussed as nucleophilic substitutions, electrophilic substitutions and additions to carbon-carbon and carbon-heteroatom multiple bonds. Therefore, the definition of –OR3 and –OR6 as “reactive

under relatively mild conditions" is considered new matter as this definition is found nowhere in the originally filed disclosure.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 109, 112-114 and 120-122 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the claims include the definition of -OR3 and -OR6 as "reactive under relatively mild conditions". These definitions render the claims indefinite as the instant claims are product claims with no limitation to reaction steps or conditions, however, the phrase "reactive under relatively mild conditions" only has meaning, see page 16, in relation to a specified reaction as the phrase "under relatively mild conditions" is associated with favored classes of reactions available and is not associated with definitions for -OR3 and -OR6. These favored classes of reactions are discussed as nucleophilic substitutions, electrophilic substitutions and additions to carbon-carbon and carbon-heteroatom multiple bonds. It is suggested that applicant delete the above mentioned phrases and include only specific values for -OR3 and -OR6, such as those found on page 17 of the specification, for example for -OR3, alkyl sulfonate or aryl sulfonate and for R6, alkyl, substituted alkyl, aryl, substituted aryl, heteroaryl, substituted heteroaryl, heterocyclyl, and substituted heterocyclyl.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday from 6:00am until 2:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Rebecca Anderson/
Primary Examiner, AU 1626*

31 March 2008

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Art Unit 1626, Group 1620
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